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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,244	12/21/2001	Nobuo Oi	2185-0602P	3414

2292 7590 03/03/2003

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

RABAGO, ROBERTO

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 03/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS2

Office Action Summary

Application No.

10/024,244

Applicant(s)

OI ET AL.

Examiner

Rob Rábago

Art Unit

1713

-- Th MAILING DATE of this communication app ars on the cov r sh t with the corr spond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____ .
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The following is noted with respect to the meaning of " α -olefin" as recited in the claims. The literature of the art is inconsistent in whether ethylene is included within the scope of " α -olefin". Based strictly on nomenclature, ethylene is an olefin, and " α " merely means that the double bond is at the first carbon, and therefore ethylene is an α -olefin. However, while the specification provides no disclosure which excludes ethylene from the scope of α -olefins, it would appear that applicants' intended scope does not include ethylene as corresponding to the α -olefin component (see specification at page 3, numbered lines 17-22). The claims are examined on the basis that ethylene is not within the scope " α -olefin". It is furthermore noted that since the claims are open-ended, ethylene may be present as long as the required monomers are also present.

Information Disclosure Statement

2. The German language reference DE 19951277 has been considered only on the basis of its English language abstract as provided by applicants.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Grigoriev et al. (US 4,226,965).

The reference describes in Examples 6 and 7 copolymers of vinylcyclohexane with 1-hexene and 1-butene, respectively, including all limitations of claims 1-4.

Regarding claim 5, the reference states at col. 1, lines 10-19, that polymers of the type disclosed are useful for the making of products which would necessarily be molded articles, such as instruments, cable insulation, and optical products.

6. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Iseki et al. (US 6,288,193 B1).

The reference describes a copolymer comprising ethylene, a vinyl compound, and an addition polymerizable monomer other than the vinyl compound, wherein the

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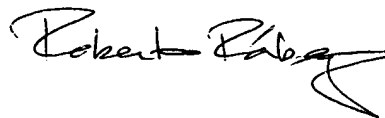
vinyl compound and the addition polymerizable monomer correspond to the monomers required in instant claims 1-4 (see col. 2, line 67 through col. 3, line 60). A specific example of such a copolymer, comprising ethylene, 1-hexene and vinylcyclohexane, is disclosed in working Example 3. As uses of the disclosed copolymers, patentee has specifically identified moldings and laminates (col. 28, lines 5-43). Regarding using the copolymer as an adhesive, the cited section discloses using the copolymer as a layer in multi-layer laminate comprising other materials such as paper, aluminum, other resins, etc., and in such applications the disclosed resin would inherently function as an adhesive layer between the surrounding layers.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rábago whose telephone number is (703) 308-4347. The examiner can normally be reached on Monday - Friday from 7:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Rob Rábago
Examiner
Art Unit 1713



RR
February 24, 2003